

Application No. 08/605,628
Amendment dated February 3, 2006
Reply to Office Action of November 7, 2005

Docket No.: S4264.0000/P001

REMARKS

Claim 1 has been amended. Claims 1-9 are now pending in the Application.
No claim has been newly added.

Claims 1 stands rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent 5,084,819 to Dewey et al ("Dewey") in view of the McDonnell article "Paying for Health Eager to Control Health-Care Costs" ("McDonnell"). According to the Office Action, at the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method/system of Dewey with the teaching of McDonnell to use the health assessments to evaluate insurability and insurance risk.

Claim 1 has been amended to overcome the instant rejection. Claim 1, as presently amended, recites, *inter alia*, "means for deleting, adding to, or changing said gathered information subsequently to having received and stored said gathered information." Support for the amendment can be found on page 19 (medical file and personal history answers may be entered at separate times), page 20 (respondents background data and personalized lifestyle answers may be entered at separate times), and page 9 (an object of the invention is to provide a system "in which past values can be correlated to present health insurance premiums subsequent to the initial evaluation so that an improvement in an individual's health can effectively result in premium rewards ... provided for those individuals who either (1) stay healthy or (2) whose health has improved since the initial survey). Dewey does not teach the above limitation. Particularly, Dewey claim 1 teaches against such a feature by requiring "means for preventing the rereading of user responses." (Col. 9, line 24). Instead, Dewey's stated objective is to allow "many users to access the system by collecting the data quickly in one transaction" and "immediately generat[ing] and print[ing] user

DSMDB.2039515.1

Application No. 08/605,628
Amendment dated February 3, 2006
Reply to Office Action of November 7, 2005

Docket No.: S4264.0000/P001

specific recommendations in response to the analyzed data.”(emphasis added)(Col. 1, lines 54-60). “

Apart from the amendment, Claim 1, line 1 further recites “[a] computer system for evaluating insurability...” Dewey does not teach the above limitation, but instead teaches against the use of computers. Since “[t]he totality of the prior art must be considered, and proceeding contrary to accepted wisdom in the art is evidence of nonobviousness,” Applicant’s use of computers in Applicant’s invention should be viewed as nonobvious. MPEP 2145(X)(D)(3). MPEP 2141.02 (VI) instructs, “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” Dewey teaches against the use of an administrator-operated computer system designed for lengthy, single-user input use, reason being, as explained in Dewey Col. 1, 36-40: “while one individual is busy answering questions others are precluded from utilizing the system and may just walk away without using and perhaps benefiting from such a system.” Dewey further teaches specifically against the use of a PC-style computer as undesirable since “[m]any people are not computer literate or worse, are computer phobic, unwilling to deal with a computer.” Col. 1, 32-33. The language in Dewey consistently refers to its invention as a “system” and does not describe the invention as a “computer” at any point, but instead teaches against the use of a computer as “complex,” undesirable, and unsuccessful in the art for various reasons (ex., the use of a monitor could allow a passerby to see the user’s information). (Col. 1, 29-39). Applicant’s Claim 1, on the other hand, explicitly requires the use of a “computer,” defined in Applicant’s specification as an “IBM-PC-compatible computer” capable of “use on a network” and maintaining several searchable databases which may be updated with additional information for a single file over time. Therefore, the use of a PC-style computer to implement a Dewey system would be a modification against the teaching of the art,

DSMDB.2039515.1

Application No. 08/605,628
Amendment dated February 3, 2006
Reply to Office Action of November 7, 2005

Docket No.: S4264.0000/P001

"proceeding contrary to accepted wisdom in the art," which is "evidence of nonobviousness." MPEP 2145(X)(D)(3).

To establish a *prima facie* case of obviousness "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings," MPEP 706.02(j). However, "[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." (emphasis added) MPEP 2143.01(V). The Office Action's rejection of Claim 1 relies on a modification, the use of a personal computer, that would render Dewey unsatisfactory for its intended purpose. Dewey expressly states its intended use is for a simple, quick, remotely operated, single transaction device. Col. 1 47-56. The drawing of Dewey Fig. 1 is illustrative of an appropriate system described by Dewey, which does not have any of the common elements of a personal computer, i.e. a mouse, a keyboard, or a monitor but only a box having a first slot for users to enter their forms into and a second slot for the box to print out a response. Accordingly, a finding of a suggestion to modify to Dewey to be implemented using personal computers is inappropriate under MPEP 2143.01(V).

Applicant further submits that the words in the Office Action describing Dewey read language into the patent that is not there, mischaracterizing the invention with general traits and terms to allow the conclusion that Dewey suggests the language of Claim 1. This is impermissible by MPEP 2141.02(II): "Distilling an invention down to the 'gist' or 'thrust' of an invention disregards the requirement of analyzing the subject matter 'as a whole.'" In particular, the list following paragraph 5 in the Office Action describes elements of Dewey in broader terms than those used in the patent. For

DSMDB.2039515.1

Application No. 08/605,628
Amendment dated February 3, 2006
Reply to Office Action of November 7, 2005

Docket No.: S4264.0000/P001

example, the Office Action suggests that Dewey discloses a computer system comprising, among other elements, "entry means for inputting said gathered information" and "a computer system database for receiving and storing said gathered information." The description in Dewey is not so broad as to cover any "entry means" as the Office Action suggests, but only describes and protects a single input means, the use of forms. Forms read by an optical reader are the only input means disclosed in the specification and claimed in the claims, and the art teaches that forms must be used to allow multiple users to access the invention. (Col. 1, lines 36-52). The scope of the claims cannot be broadened in regards to input means to include all "entry means" for the purpose of reading Dewey onto Applicant's Claim 1, particularly as such broadening would include means that the art teaches against. This amounts to characterizing the invention by "gist" instead of analyzing it for its limitations as a whole.

Concerning the Office Action's description, "a computer system database for receiving and storing said gathered information," the phrase "computer system database" is not found in Dewey, nor used in describing the means of storing information. In fact, Dewey does not mention any form of memory organization, critically, not anything as complicated, useful or limited as a "computer system database." To support this description, the Office Action refers to Col.3, lines 9-42. Although Dewey does mention memory elsewhere, the closest these lines approach to describing anything related to memory is found in lines Col. 3, lines 19-21: "Additionally, the system may provide a summary report listing a tabulation of the responses from a number of users." A "computer system database" cannot be inferred from this description, nor can a computer system database be found to be an obvious means of implementing this feature to one skilled in the art when Dewey teaches

DSMDB.2039515.1

Application No. 08/605,628
Amendment dated February 3, 2006
Reply to Office Action of November 7, 2005

Docket No.: 54264.0000/P001

against the use of computers. These phrases and characterizations further distill the invention down to its "thrust" or "gist".

Finally, Claim 1 recites the use of a computer system "for evaluating insurability of at least one individual." According to the Office Action, Dewey does not disclose the use of the system for insurable risk assessment. The Office Action relies on McDonnell to cure this deficiency, stating that:

"it would have been obvious to one of ordinary skill in the art to modify the method/system of Dewey with the teaching of McDonnell to use the health assessments to evaluate insurability and insurance risk. As suggested by McDonnell, one would have been motivated to include this feature to slow the growth of healthcare costs (McDonnell: par. 2) and to provide insureds with specific health information to reduce insurance costs while improving their health (McDonnell: par. 33)"

By the Office Action's reasoning, the motivation to modify Dewey is "to slow the growth of healthcare costs, etc."; however, McDonnell only teaches that getting health assessments may have these effects. The Office Action does not address whether McDonnell makes any suggestion as to the means of providing such an assessment. McDonnell does not suggest there is a problem with the then-current means of providing a health assessment, namely, going to a doctor. McDonnell does teach, however, that motivating payments are made to insureds for going to "get screened for heart disease and cancer risk." (McDonnell: par. 14) Such actions must take place in a hospital or a doctor's office and do not suggest the use of an automated, remote, Q&A system such as provided by the present invention, or how to combine a means of providing such information in combination with Dewey. Accordingly, since McDonnell only reports the use of health assessments but teaches towards the use of a

DSMDB.2039515.1

Application No. 08/605,628
Amendment dated February 3, 2006
Reply to Office Action of November 7, 2005

Docket No.: S4264.0000/P001

hospital/doctor as the means of obtaining the assessment as opposed to using a system such as Dewey, there is no teaching for a computer system for performing the invention as claimed.

For at least the above reasons, neither Dewey alone or in combination with McDonnell teach or suggest the limitations of Claim 1. Accordingly, Applicant respectfully requests that the rejection of Claim 1 be withdrawn.

Claim 2 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Dewey in view of McDonnell. This rejection is respectfully traversed. Claim 2 depends from Claim 1 and thus recites the limitations of Claim 1. As described above, Dewey in view of McDonnell fails to teach or suggest the limitations of Claim 1. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

Claim 3 stands rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Dewey and McDonnell in view of U.S. Patent 4,975,840 to DeTore et al. ("DeTore"). This rejection is respectfully traversed. Claim 3 depends from Claim 1 and thus recites the limitations of Claim 1. As described above, there is no suggestion or motivation to combine Dewey and McDonnell, and Dewey in view of McDonnell fails to teach or suggest the limitations of Claim 1. Furthermore there is no suggestion or motivation in the prior art to combining De Tore with Dewey and McDonnell. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

Claim 4 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Dewey in view of McDonnell. This rejection is respectfully traversed. According to the Office Action, "Dewey discloses a computer system further comprising a questionnaire database means to store a questionnaire." The Office Action relies on Col. 3, lines 9-52, Table 1, Col. 4 lines 67-Col. 5 line 35, and Col. 8 lines 43-48. None of these lines mention

DSMDB.2039515.1

Application No. 08/605,628
Amendment dated February 3, 2006
Reply to Office Action of November 7, 2005

Docket No.: S4264.0000/P001

the phrase "computer system" nor "questionnaire database" and thus do not support the rejection. Furthermore, Claim 4 depends from Claim 1 and thus recites the limitations of Claim 1. Accordingly, at least for the reasons regarding the discussion of Claim 1, Applicant respectfully requests that this rejection be withdrawn.

Claim 5 stands rejected as being unpatentable over Dewey and McDonnell and in further view of the Lynch article "Stay Healthy: Pay Le\$\$ for Health Insurance" ("Lynch"). This rejection is respectfully traversed. Claim 5 depends from Claim 1 and thus recites the limitations of Claim 1. However, Lynch fails to overcome the above-noted deficiencies of Dewey and McDonnell. Lynch does not teach the use of a computer system for evaluating insurability having the limitations of Applicant's Claim 1. Therefore, Applicant respectfully requests that this rejection be withdrawn.

Claim 6 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Dewey in view of McDonnell. This rejection is respectfully traversed. Claim 6 depends from Claim 1 and thus recites the limitations of Claim 1. As described above, Dewey in view of McDonnell fails to teach or suggest the limitations of Claim 1. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

Claim 7 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Dewey in view of McDonnell. This rejection is respectfully traversed. The Office Action states that Dewey teaches a method of a "computer system determining a total value based on said assigned risk values," however the Office Action did not explain where the "said" risk values were disclosed in Dewey. Office Action pg. 7. Accordingly, Dewey does not disclose the limitation of Claim 7 of "assigning of risk values by said computer system to each of said weight values that represent levels of insurance risk."

DSMDB.2039515.1

Application No. 08/605,628
Amendment dated February 3, 2006
Reply to Office Action of November 7, 2005

Docket No.: S4264.0000/P001

Furthermore, the Office Action's rejection of Claim 7 describes Dewey using similar language to the rejection of Claim 1, stating that Dewey teaches "a method of evaluating in a computer system," and storing information in "a database in said computer system." For reasons similar to those described above, Dewey in view of McDonnell fails to teach or suggest the limitations of Claim 7 in that Dewey teaches against the use of computers and does not teach the use of databases. Additionally, McDonnell does not suggest modifying Dewey to use for determining insurable risk. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

Claim 8 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Dewey in view of McDonnell and DeTore. This rejection is respectfully traversed. Claim 8 depends from Claim 7 and thus recites the limitations of Claim 7. As described above, there is no suggestion or motivation to combine Dewey and McDonnell, and Dewey in view of McDonnell fails to teach or suggest the limitations of Claim 1. Furthermore there is no suggestion or motivation in the prior art to combining DeTore with Dewey and McDonnell. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

Claim 9 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Dewey in view of McDonnell. This rejection is respectfully traversed. The Office Action's rejection of Claim 9 describes Dewey using similar language to the rejection of Claim 1, stating that Dewey teaches "a method of evaluating in a computer system," and storing information in "a database in said computer system". For reasons similar to those described above, Dewey in view of McDonnell fails to teach or suggest the limitations of Claim 9 in that Dewey teaches against the use of computers, and does not teach the use of databases. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

DSMDB.2039515.1

Application No. 08/605,628
Amendment dated February 3, 2006
Reply to Office Action of November 7, 2005

Docket No.: S4264.0000/P001

Since the Examiner has withdrawn all prior §101 rejections and the §103(a) rejection based upon Dewey in view of McDonnell cannot stand for the above stated reasons, Applicant respectfully resubmits that this pending Application is in condition for allowance.

Dated: March 24, 2006

Respectfully submitted,

By _____
Jon D. Grossman
Registration No.: 32,699
DICKSTEIN SHAPIRO MORIN &
OSHINSKY LLP
2101 L Street NW
Washington, DC 20037-1526
(202) 785-9700
Attorney for Applicant

DSMDB.2039515.1

15